REMARKS

Claims 39, 41-43, 45-48, 50, 51, 53, 54, 56, 57, 60, 62-65 and 67-69 were pending when last examined. By the present Response, claims 39, 48, 54, and 64 have been amended. No new matter has been introduced. Support for the amendment can be found at least in page 2, FIGS. 1-3 and 5, the corresponding description in the specification.

Claim Rejections – 35 USC § 103

Claims 39, 41-43, 45-48, 50, 51, 53, 54, 56, 57, 60, 62-65, 67, and 69 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,704,929 to Ozer et al. ("Ozer") in view of U.S. Patent No. 7,051,352 to Schaffer ("Schaffer") in view of U.S. Patent No. 6,188,869 to Chan ("Chan") and further in view of U.S. Patent No. 6,128,652 to Toh ("Toh"). Applicants respectfully traverse the rejections.

Claim 39, as amended, recites a method that includes, in part, receiving a multimedia program having a program identifier, receiving content description about the multimedia program, collecting information about consumption of multimedia content, and storing a usage history in the apparatus. The usage history includes a user action list that is separate and distinct from the content description and includes a user action item corresponding to the user action. The user action item of the usage history includes the program identifier and a link to a particular location where a specific element of the content description about the multimedia program is located. The method also includes using the link in the user action item of the usage history to generate user preference information.

In rejecting this claim, the Examiner has combined not less than four references to obtain the claimed subject matter, and asserted that such a combination would have been obvious at the time the present invention was made. Applicants respectfully disagree.

The present application, in part, sets out to solve the problem of organizing usage history information so that it (i) can be efficiently used to generate user preference information and (ii) does not waste storage space or create large data structures by unnecessarily duplicating information which is available at other places. *See* specification at

3:18-4:10. Ozer and Schaffer are concerned with similar problems but fail to disclose or suggest the claimed solution.

Ozer explains that electronic program guide information "can be selected for inclusion in viewing behavior information compiled at the home entertainment system." Ozer at col. 11:47-51 and FIG. 4. Thus, Ozer teaches creating viewing behavior information which includes a second, duplicate copy of the same information which is also available in the program guide. *Id.* at col. 11:52-61. Like the present application, Ozer realizes that "compiling full viewing behavior information at the home entertainment systems" may require too much "data processing, storage, and transmission requirements of the home entertainment system." *Id.* at col. 12:18-26. Ozer suggests solving this problem by limiting the viewer behavior information "to as little as a unique ID associated with a channel and a unique ID associated with a television program ... [so that] the clearing house provides all of the other descriptive information from a copy of the electronic program guide to generate and store a comprehensive record of the viewing behavior." *Id.* at col. 12:26-34. Here, Ozer suggests performing the same data duplication and processing that was performed in the home entertainment systems, only this time at a different location, in the clearing house. *Id.* at col. 12:34-37. But instead of duplicating information as Ozer teaches, the claim requires the user action item to include a link to a particular location where a specific element of the content description about the multimedia program is located. Thus, Ozer fails to disclose the present inventors' solution.

Schaffer also realizes the problems related to generating "viewer history without a large amount of storage or computing effort." Schaffer at col. 3:4-7. But similar to Ozer, Schaffer also fails to find the claimed solution which requires the user action item to include a link to a particular location where a specific element of the content description about the multimedia program is located.

The Examiner acknowledges that Ozer and Schaffer do not disclose the claimed link in the user action item, and points to Chan. Chan discloses embedding user selectable links, such as HTML tags containing URL addresses, into broadcast information to be displayed. *See* Chan at col. 8:7-27. But unlike Ozer and Schaffer, Chan is not concerned at all with

efficiently organizing user history data. Yet, the Examiner asserts that Chan can be combined with Ozer and Schaffer:

> ... as Schaffer discloses a user history with a description field and as Chan teaches adding HTML links to a field of text; the examiner interprets this combination as using the links in the description to create the user action history...
> *See* Office Action dated 02/05/2008 at 4.

Applicants believe that the Examiner's combination is based on impermissible hindsight. [1]

Ozer and Schaffer were filed less than one year before the present application's priority date. As discussed above, similar to the present application, both Ozer and Schaffer realize and try to solve problems which are related to organizing user history data. Yet, neither Ozer nor Schaffer discloses or suggests the solution of using a link in the user action item as claimed in the present application. In light of this contemporaneous failure of these other inventors, and given that Chan is not directed to and does not even mention problems of organizing user history data, applicants submit that making the combination suggested by the Examiner would have taken more than ordinary skill in the art at the time. Thus, the Examiner's combination of Chan with Ozer and Schaffer was not obvious, and resulted from the hindsight gained from the present application.

But even this suggested combination of three references, as the Examiner admits, fails to disclose the claimed link in the user action item, and the Examiner points to Toh for the missing subject matter. Toh, like Schaffer, discloses the use of URL links in structures other than the claimed user action items and lacks any reference to organizing user history. Accordingly, there is no motivation to combine Toh in the suggested way with any of the Ozer or Schaffer references.

In sum, the cited references fail to disclose or fairly suggest the claimed user action item including the program identifier and a link to a particular location where a specific element of the content description about the multimedia program is located. Thus, no *prima*

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[1] As discussed in the Response dated October 31, 2007, the applicants also believe that the motivation alleged by the Examiner to make that combination is misplaced as the Examiner refers to a "known programming language" and "having to create a new API" which are unrelated and irrelevant to the specific issue of organizing user history information.

facie case of obviousness has been made, and claim 39 should be allowable. Claims 41-43, 45-47, 60 and 69 depend from claim 39 and are allowable for at least the same reasons.

Independent claims 48, 54, and 64 require limitations similar to those discussed above with reference to claim 39. Because the combination cited by the examiner fails to disclose or suggest those limitations, claims 48, 54 and 64 should also be allowable. Claims 50, 51, 53, 56, 57, 62, 63, 65 and 67 are dependent claims which are allowable for at least the same reasons as their respective base claims.

Claim 68 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,704,929 to Ozer et al. ("Ozer") in view of U.S. Patent No. 7,051,352 to Schaffer ("Schaffer") in view of U.S. Patent No. 6,188,869 to Chan ("Chan") and further in view of U.S. Patent No. 6,128,652 to Toh ("Toh") and further in view of U.S. Patent No. 5,956,037 to Osawa ("Osawa"). Applicants respectfully traverse the rejection.

Claim 68 depends from claim 39 and incorporates by reference all of its limitations. As discussed above, Ozer, Schaffer, Chan and Toh fail to disclose or suggest the claimed user action item including the program identifier and a link to a particular location where a specific element of the content description about the multimedia program is located. Osawa is also lacking. Thus, no *prima facie* case of obviousness has been made, and claim 68 should be allowable.

CONCLUSION

Applicants respectfully request that the pending claims be allowed and the case passed to issue. Should the Examiner wish to discuss the Application, it is requested that the Examiner contact the undersigned at (415) 772-7493.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

8/1/08   Richard O Pak

Date   Signature

Respectfully submitted,

By: _____
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